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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,734	09/27/2003	Soledad Wang	Corsina010856	9448
7590	02/16/2006			
Soledad Wang 24300 East 98th Street Broken Arrow, OK 74014			EXAMINER HWANG, VICTOR KENNY	
			ART UNIT 3764	PAPER NUMBER
DATE MAILED: 02/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/672,734	Applicant(s) WANG, SOLEDAD	
	Examiner Victor K. Hwang	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>Sept. 27, 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: on page 1, under the heading "CROSS-REFERENCE TO RELATED APPLICATIONS", the recitation of the U.S. Patent Documents should be deleted because it does not conform to the requirements of 37 CFR 1.78 and MPEP 201.11.

Appropriate correction is required.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the body of the specification as originally filed does not describe that the individual will be in the supine position while performing exercises (claim 4); or the twenty facial exercises for the weights (claims 1 and 5).

Drawings

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the black and white photographs of Figs. 7-12 do not satisfy the requirements for permitting black and white photographs. See 37 CFR 1.84(b)(1). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first and second paragraphs of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph as having undue breadth. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983). MPEP 2164.08(a).

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 provides for the use of facial weights, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex*

parte Dunki, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F.

Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 2-4 are rejected under 35 U.S.C. 102(b) as being anticipated by *Dereszynski* (US Pat. 6,224,517 B1). *Dereszynski* discloses weights 10 comprising a flexible water resistant external covering 18, such as nylon with a plastic inner lining, flexible plastic material, or Neoprene; weighted material, such as liquid, sand, gel, steel pellets, or plastic pellets; and the covering sewn to conform to various fixed sizes and shapes. The devices can weight between 2 and 30 pounds. This is within the claimed range of 227 gm to 1 kg. One of the shapes disclosed (Fig. 1) is elongate with narrow mid-section and wide ends. The weights are capable of being used in a supine position.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Rooney* (US Pat. 4,189,141). *Rooney* discloses a method of toning and developing the muscles of the face by contracting facial muscles against resistance provided by means of specifically designed facial weights 70, 76, 80, 82 and 86 in varying sizes and shapes. Several specific facial exercises are disclosed using the facial weights (col. 3, lines 16-42). Other exercises can be prescribed. The list is only exemplary of the types of exercises which may be performed (col. 3, lines 43-45).

Rooney does not disclose twenty specific exercises designed for the facial weights.

It would have been obvious to one having ordinary skill in the art at the time the invention was made that twenty exercises could be designed for the facial weights, since *Rooney* discloses that the list is only exemplary and that other exercise can be prescribed for use with the device.

Allowable Subject Matter

11. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following claims are drafted by the examiner and considered to distinguish patentably over the art of record in this application, claims 6-20 are presented to applicant for consideration:

6. A set of facial weights for use in facial muscle exercise comprising:

a plurality of flexible facial weights sized and configured to be placed upon and supported by the skin surface of a user's face;

said plurality of flexible facial weights comprising at least one elongate shaped weight having a narrow mid-section and wide ends, and at least one irregular shaped weight having an oval-like shape; and

each flexible facial weight comprising a flexible, water resistant external covering and weight material contained within said external covering so that each flexible facial weight is between 227 gm and 1 kg in weight, wherein the plurality of flexible facial weights are selectively placed over various portions of a user's face to provide resistance to exercise of selected muscles of the face.

7. The set of facial weights for use in facial muscle exercise of claim 6, wherein said weight material comprises steel beads.

8. The set of facial weights for use in facial muscle exercise of claim 6, wherein the flexible, water resistant external covering comprises vinyl material.

9. The set of facial weights for use in facial muscle exercise of claim 6, wherein the flexible, water resistant external covering comprises simulated leather material.

10. The set of facial weights for use in facial muscle exercise of claim 6, wherein one of said at least one elongate shaped weights comprises weight material to provide a weight of 1 kg, has a length of approximately 24 cm, a width of approximately 9 cm at its wide ends, and a width of approximately 5 cm at its narrow mid-section.

11. The set of facial weights for use in facial muscle exercise of claim 6, wherein one of said at least one elongate shaped weights comprises weight material to provide a weight of 681 gm, has a length of approximately 23 cm, a width of approximately 8 cm at its wide ends, and a width of approximately 5 cm at its narrow mid-section.

12. The set of facial weights for use in facial muscle exercise of claim 6, wherein one of said at least one irregular weights comprises weight material to provide a weight of 766 gm, a greatest length of approximately 14 cm, a greatest width of approximately 10 cm, and a second width at an apex of approximately 5.5 cm.

13. The set of facial weights for use in facial muscle exercise of claim 6, wherein one of said at least one irregular weights comprises weight material to provide a weight of 454 gm, a greatest length of approximately 12 cm, a greatest width of approximately 8.5 cm, and a second width at an apex of approximately 5.25 cm.

14. The set of facial weights for use in facial muscle exercise of claim 6, wherein one of said at least one irregular weights comprises weight material to provide a weight of 284

gm, a greatest length of approximately 12 cm, a greatest width of approximately 9 cm, and a 5 mm indentation at its center.

15. The set of facial weights for use in facial muscle exercise of claim 6, wherein one of said at least one irregular weights comprises weight material to provide a weight of 227 gm, a greatest length of approximately 12 cm, a greatest width of approximately 9 cm, and a 10 mm indentation at its center.

16. The set of facial weights for use in facial muscle exercise of claim 6, wherein said flexible, water resistant external covering for each flexible facial weight comprises two pieces of material of identical size and shape sewn together.

17. The set of facial weights for use in facial muscle exercise of claim 16, wherein said flexible, water resistant external covering of said at least one elongate shaped weights comprises vinyl material.

18. The set of facial weights for use in facial muscle exercise of claim 17, wherein each piece of vinyl material for said at least one elongate shaped weights further comprises 4 to 6 pleats.

19. The set of facial weights for use in facial muscle exercise of claim 16, wherein said flexible, water resistant external covering of said at least one irregular shaped weights comprise simulated leather material.

20. The set of facial weights for use in facial muscle exercise of claim 19, wherein each piece of simulated leather material for said at least one irregular shaped weights further comprises 1 to 2 pleats.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Foley (US Pat. 3,814,428), *Kraushaar* (US Pat. 5,165,694), *Schlager* (US Pat. 5,465,458), *Neding* (US Pat. 5,655,777), *Spano* (US Pat. 5,938,572) and *Williams* (US Pat. 6,149,557) disclose various weighted devices satisfying the claimed shape.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor K. Hwang whose telephone number is (571) 272-4976. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM Eastern time.

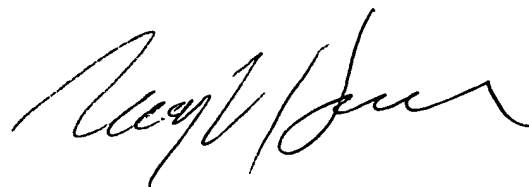
The facsimile number for submitting papers directly to the examiner for informal correspondence is (571) 273-4976. The facsimile number for submitting all formal correspondence is (571) 273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on (571) 272-4887.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor K. Hwang
February 13, 2006



GREGORY L. HUSON
SUPERVISORY PATENT EXAMINER
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